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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/663,180

09/15/2003

Dennis O. Donnelly

1430

7590

04/19/2005

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EXAMINER

TRUONG, BAO Q

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,180

Applicant(s)

DONNELLY, DENNIS O.

Examiner

Bao Q. Truong

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/18/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 1-8 are objected to because of the following informalities:

Claim 1, "comprising" in lines 2 and 7 should be changed to –including–; "its" in last line should be changed to what it refers.

Claim 2, "its" in line 5 should be changed to what it refers.

Claims 3, 4, 5 and 6 the preamble does not match.

Claim 7, "comprising" in lines 6 and 14 should be changed to –including--.

Claim 8, "the LED lamp(s)" should be changed to –the LED-- for consistency.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 2-6 and 8-10 are necessary included because of their dependency.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Zelina [US 4,181,928].

Regarding claim 11, Zelina discloses a battery holder [11], a battery [33, 34], a plurality of walls [13, 14], a ceiling [15], a cap [20], an open end [29, 30], battery contacts [45], a battery connector [44], a plurality of detents [16, 17] for mating to and retaining the cap [20], and a means [53] for attaching the battery holder [11] to a surface (figures 1 and 2).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kutnyak [US 4,431,196] in view of Balogh et al. [US 5,290,184].

Regarding claims 1 and 7, Kutnyak discloses an illuminated flying disc toy having a lightweight circular disc [10], a rim [16], a separately constructed illumination kit [21], a lighting circuit [29, 30], a plurality of light emitting diodes [11, 12, 13], wires [29, 30], a battery holder [22] and a battery connector [27] for connecting/disconnecting the lighting circuit to a battery [25] (figures 2 and 4). Kutnyak does not disclose the resistor.

Balogh et al. teaches the use of resistor in a lighting circuit to form a voltage divider network (figures 2 and 7, column 4 lines 52-61, column 5 lines 5-10).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the lighting circuit of Kutnyak by a resistor as taught by Balogh to form a voltage divider network for purpose of providing a longer battery life.

Regarding claim 2, Kutnyak discloses a battery holder [22], a circular wall, means [35] for attaching the battery holder [22] to a surface and a ceiling element [23] (figures 2, 4 and 5).

Regarding claims 3, 8 and 9, Kutnyak discloses the battery holder [22] attached to a lower surface of a flying disc [10] with a rim [16], and the light emitting diodes [11, 12, 13] illuminating the surface and the rim (figures 1-5).

Regarding claims 4, 6 and 10, Kutnyak discloses the illumination device being replaceable (abstract, figures 1-9, column 2 lines 6-12).

Regarding claim 5, Kutnyak discloses the illumination device [21] being attaches to an arbitrary object [10].

***Conclusion***


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moffitt [US 4,307,538] discloses an illuminated disc toy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Q. Truong whose telephone number is (571) 272-2383. The examiner can normally be reached on Monday-Friday (8:00 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bao Q. Truong  
Examiner  
Art Unit 2875

  
**JOHN ANTHONY WARD**  
**PRIMARY EXAMINER**